

REMARKS

This request for reconsideration is in response to the Official Action dated March 27, 2005. Claims 1, 3, 5, and 7-13 are currently pending in connection with the present application. Claims 1, 3, and 5 are independent claims. In this amendment, no claims have been canceled, amended, or added. Reconsideration and allowance is requested in view of the following remarks.

Applicant acknowledges the withdrawal of the rejections under 35 USC § 112, second paragraph.

Information Disclosure Statements

Applicant acknowledges and thanks the Examiner for the review of the Information Disclosure Statements filed August 25, 2006 and November 29, 2006.

With respect to the Information Disclosure Statement filed August 25, 2006, Applicant submits that the IDS included a typo, inadvertently reciting JPO action 2002-079529, instead of JPO action 2002-079529. Applicant graciously requests that the examiner correct this mistake on the previously submitted IDS and review the reference.

With respect to the Information Disclosure Statements filed August 25, 2006, Applicant submits that English translations for JP 59-135698, JP 7-65586, and JP 9-63286 are provided in the disclosed supplement to the IDS filed August 25, 2006. Applicant believes that no fee is due for the supplemental IDS, however, if a fee is due, please charge the Deposit Account provided at the conclusion of this response.

The Finality of the Present Office Action is Improper because the Examiner failed to properly address applicant's arguments with regard to pre-existing claims 1, 3, 5, and 7

“Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an*

information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” MPEP § 706.07(a) (emphasis added).

“[W]here a single previous office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also *should include a rebuttal of any arguments raised in applicant's reply.*” MPEP § 706.07 (Statement of Grounds)(emphasis added)

In the present case, Applicant’s amendments to claims 1, 3, 5, and 7 did not necessitate new grounds of rejection because Applicant’s *amendments only shifted pre-existing claimed subject matter* from the dependent claims (2, 4, and 6) to the independent claims (1, 3, and 5). In the present office action, the Examiner states that all arguments regarding the original claims are moot. This statement is incorrect. None of Applicant’s amendments regarding the original claims (1, 3, and 5) introduced previously unclaimed subject matter, and therefore did not render moot any of the examiner's previous allegations regarding patentability. On the contrary, Applicant’s amendments to claims 1, 3, and 5 only incorporated dependent claims into independent claims. Therefore, the examiner was obligated to (but did not) respond to Applicant’s arguments in order to maintain a prima facie case against patentability.

While finality may have been proper had the examiner provided a proper response addressing Applicant’s arguments to claims 1, 3, 5, and 7 and addressing new claims 8-13, the present action was made final improperly particularly because it failed to properly address Applicant’s arguments (disclosed in Applicant’s previous reply dated November 27, 2006) regarding claims 1, 3, 5, and 7.

Accordingly, Applicant respectfully requests that the Examiner issue a new office action properly addressing all of Applicant’s previous and present arguments.

35 USC § 102 Rejections

At least for the following reasons, if the allowance of the claims is not forthcoming and a new ground of rejection made, then a **new Office Action** is respectfully requested.

Claims 1, 3, 5, and 7-8 have been rejected under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 5,412,402 to Searby et al. (Searby).

None of the claims have been amended. Claims 1, 3, 5, and 7 retain the subject matter disclosed in the original claims set (only incorporating subject matter from original claims 2, 4, and 6, respectively).

With respect to claim 1, Applicant submits that Searby fails to teach or suggest “[a] *data storage circuit*

“characterized by providing a comparison section for reading out existing data stored in a storage element to compare said existing data and new data with each other prior to writing of said new data to said storage element, and configuring so that, in said comparison section, in a case where said existing data and said new data are identical with each other, the writing to said storage element is not performed, and in a case where said existing data and said new data are not identical with each other, said new data is written to said storage element; and

“characterized by providing a control signal generating section for generating a readout control signal for performing readout control of said existing data and a write control signal for performing write control of said new data, and by configuring so that said existing data and said new data are compared with each other in said comparison section in accordance with said write control signal from said control signal generating section.”

Explaining the effects of a claim preamble to claimed structure the MPEP states:

“Any terminology in the preamble that limits the structure of the claimed invention must be **treated as a claim limitation**. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989) (The determination of whether preamble recitations are structural limitations can be resolved only on review of the entirety of the application “to gain an understanding of what the inventors actually invented and intended to encompass by the claim.”); *Pac-Tec Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 USPQ2d 1871, 1876 (Fed. Cir. 1990) (determining that preamble language that constitutes a structural limitation is actually part of the claimed invention). See also *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987).

MPEP § 2111.02 I (Explaining that structural matter in the claim preamble is a claim limitation).

First, Searby fails to teach or suggest “a data storage **circuit**” or “device.” Instead, Searby is directed to the electronic graphics **system** for painting an image including *user input devices* (stylus 7, color selection component 6, and brush shape selection component 10), *output devices* (monitor 5), and *various system components*. Furthermore, Searby also teaches that various components of the graphics system are implemented algorithmically (column 3, line 51; column 6, lines 32-35; column 7, line 44, citing to interpolation algorithms; column 8, lines 46-48, citing to alternative algorithms). Searby also discloses that various elements of the graphics system consist of independent devices. (e.g., bulk storage device 2 may consist of a Fujitsu disk pack or a Sony digital video tape recorder; column 5, lines 46-50). MPEP §2111.02, cited above, clearly states that limiting structural elements disclosed in a preamble have patentable weight. However, Searby does not disclose either a single circuit or device. Therefore, Searby does not teach or suggest a circuit as disclosed in independent claim 1.

Second, Searby fails to teach or suggest “a **control signal generating section for generating a readout control signal** for performing readout control of said existing data”. The examiner states, “the control signal generating section, while not shown, must exist in order for the circuit to know when to read control signal image data K and brush coefficient K_B.” It is

respectfully submitted that the outstanding Office Action does not provide a rationale or evidence *tending to show inherency* (in terms of a certainty) for the statements included in the Official Action regarding claim 1, as required by MPEP §2112 VI. MPEP §2112 VI titled “*Examiner Must Provide Rationale or Evidence Tending to Show Inherency*” states, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency or the result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534; 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Still further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily flows** from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter 1990). **For Inherency to apply, a result cannot be feasible by any other method.** In the present case, there is no basis in necessity or inherency for a **control signal generating section**. On the contrary, Searby clearly indicates that various aspects of the disclosed invention are implemented in software, which would remove the need for any control signal generation section altogether. While the Examiner alleges that Searby cannot exist without a **control signal generating section**, Applicant submits that the comparator component along with much of the Searby system may be implemented in software, thereby removing the need to implement a signal generation section as disclosed in Applicant’s claims. The fact that such an alternative implementation is possible, by definition, proves that such structures are not inherent.

Third, Applicant submits that Searby does not teach or suggest “a readout control signal for performing readout control of said existing data and a write control signal for performing the write control of said new data.” Instead, Searby discloses that comparator 13 outputs a signal dependent on the relationship between the control image data K and the brush coefficient data K_B . In particular, comparator 13 and gate 15 are arranged such that gate 15 only connects the output from the brush coefficient store 12 to the control image store 14 when the value of the brush coefficient pixel is greater than that of the corresponding control image pixel. Essentially, gate 15 only provides a signal to comparator 13 when the value of corresponding brush coefficient pixel K_B is greater than image data K. Therefore, gates 13 and 15 cannot correspond to Applicant's control signal generating section because they only produce a single signal, i.e. a write signal input to control

image store 14. Similarly, control image store 14 cannot correspond to the control signal generating section because it also fails to produce both a readout and a write signal, instead only accepting a read signal from the patch address generator and producing a read value K to gate 13. As discussed above, the examiner indicates “the control signal generating section, while not shown, must exist”. However, as stated above, various alternative implementations of the Searby invention are possible (e.g. column 8, lines 46-48) which would not include a control signal generating section for generating a readout control signal and a write control signal. Accordingly, the examiner's inherency argument regarding the control signal generating section fails. However, even if the inherency argument did not fail, the examiner has not shown why the inherent “control signal generating section” would include a readout and write control signal. Therefore, Applicant reasserts that Searby fails to teach both a readout control signal and a write control signal as disclosed in independent claim 1.

Finally, Applicant reasserts those arguments set forth in the previous office action regarding claims 1, 3, 5, and 7 (containing subject matter originally claimed in canceled claims 2, 4, and 6) to which the examiner did not address in the outstanding office action. Applicant respectfully requests that the examiner review and respond to those arguments set forth in the previous office action regarding claims 1, 3, 5, and 7, as well as those arguments set forth above.

With respect to claim 8, Applicant submits that Searby fails to teach or suggest “wherein said readout signal and said write control signal are derived from a write signal input to said control signal generating section.” In setting forth the rejection, the examiner cites to stylus 7 as producing both a write control and read control signal. However, Applicant submits that stylus 7 more appropriately represents the source of new data, and not a source for various control signals.

Searby therefore fails to disclose, teach, or suggest various features of independent claim 1 and 8. For similar reasons, independent claims 3 and 5 are neither disclosed nor suggested by Searby (although claims 1, 3, and 5 should be interpreted solely based upon the limitations set forth therein).

Accordingly, Applicant respectfully requests that the rejection of independent claim 1, 3, and 5 and dependent claims 7-8 under 35 U.S.C. § 102(b) be withdrawn.

35 USC § 103 Rejections

Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Searby in view of Moyer (US Patent No. 6,052,302). Applicant respectfully traverses this rejection.

The alleged motivation cited by the Examiner for combining Searby and Moyer to reject claim 9, is that “it would help minimize power consumption.”

Applicant asserts that the Examiner’s alleged motivation is based upon Applicant’s own disclosure and is therefore an improper use of hindsight. The Examiner merely viewed the present application, and attempted to select prior art containing an “AND logic gate,” without citing specific evidence of motivation to combine the references, other than providing conclusory statements regarding the motivation and obviousness. Accordingly, absent such motivation, a prima facie case of obviousness under 35 U.S.C. §103(a) has not been established and the rejection must be withdrawn.

Applicant directs the Examiner's attention to two cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir. 1999) and *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination made by the Applicant. The motivation suggestion or teaching may come explicitly from one of the following:

- (a) the statements in the prior art (patents themselves)

- (b) the knowledge of one of ordinary skill art, or in some cases,
- (c) the nature of the problem to be solved.

See Dembiczak 50 USPQ at 1614 (Fed.Cir. 1999).

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. *See Dembiczak* 50 USPQ2d at 1617. Broad conclusory statements standing alone are not “evidence.”

Neither Searby nor Moyer teach or suggest combining their features to arrive at independent claim 1; nor does the Examiner cite any particular passage to provide evidence that such a combination would be obvious to one of ordinary skill in the art. On the contrary, the disclosed references seek to overcome differing problems and therefore do not constitute an obvious combination.

Searby discloses an electronic graphics system for painting images using a stylus and having storage capability. Moyer is directed to a bitwise conditional write method and apparatus for MRAM chips. In particular, Moyer discloses logical state circuits for storing bits of data. While, both references relate to computers and technology generally, the references are significantly different with respect to their technical teachings. Searby discloses a complete system including a stylus, monitor, data drives, and various software components designed to provide a non-technical artist with the ability to modify pictures and images. By contrast, Moyer discloses a specific improvement for engineering memory cells. Whereas, Searby combines multiple devices to create a complete system, Moyer only improves a single component in an integrated circuit.

Given the distinct and differing problems solved by the references, neither reference provides any evidence teaching or suggesting their combination. Thus, it would not have been obvious to one of ordinary skill in the art to combine the teachings of Searby and Moyer.

Relying on common knowledge or common sense of a person of ordinary skill in the art without any specific hint or suggestion of this in a particular reference is not a proper standard for reaching the conclusion of obviousness. *See In re Sang Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002).

Further, relying on obvious design choice as a reason for combining teachings of the various references is again not the proper standard for obviousness. If the Examiner is relying on personal knowledge to support a finding of what is known in the art, the Examiner must provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding. *See* 37 CFR 1.104(d)(2) and MPEP 2144.03(c). In view of the above arguments, Applicants assert that the Examiner has not established the required motivation for combining the teachings of Searby and Moyer and therefore fails to establish a prima facie case of obviousness under 35 U.S.C. §103(a).

Applicant further submits that even if Searby and Moyer were combinable (which applicant does not admit) the combination would still fail to teach Applicant's claimed invention. In rejecting claim 8, the examiner compared stylus 7, disclosed in Searby, with Applicant's "control signal generating section." In making the present rejection, the examiner combines the MRAM related AND gates, disclosed in Moyer, to the stylus 7, disclosed in Searby, to overcome Applicant's claim 9. There is no basis (nor has the examiner offered any basis) for including MRAM circuitry within stylus 7 (a simple peripheral device) disclosed in Searby. Therefore, the examiner has failed to provide a prima facie case overcoming claim 9. If Searby and Moyer were combinable, a more likely location for the AND gate disclosed in Moyer would be in the memory or storage components of Searby, not in the stylus.

Since, even a combination of the relied upon references would still fail to yield the claimed invention, Applicant submits that a prima facie case of obviousness for claim 9 has not been presented. Applicant also notes that the offered combination appears to be a (failed) attempt to reconstruct the claimed invention in hindsight, as there is no basis to combine Searby with Moyer.

For similar reasons stated above claim 13, and the associated "XOR gate" also overcome the Searby and Moyer rejection (although claims 8 and 13 should be interpreted solely based upon the limitations set forth therein).

Accordingly, Applicant respectfully requests that the rejection of dependent claims 9 and 13 under 35 U.S.C. § 103(a) be withdrawn.

Claim 10-12 have been rejected under 35 U.S.C. § 103 as being unpatentable over Searby in view of Kunikiyo(US PGPub. No. 2002/0145902). Applicant respectfully traverses this rejection.

For similar reason to those set forth regarding Searby and Moyer, there is no motivation to combine Searby and Kunikiyo. Particularly, whereas Searby discloses an entire electronic graphical system, Kunikiyo discloses an improvement for a memory circuit. While, both references are directed to computers and technology generally, that alone does not suffice to provide motivation to combine the references. The references differ significantly with respect to their technical teachings. Searby is directed to a complete system, whereas, Kunikiyo is directed to a specific technique for engineering memory cells. There is no basis for the inventor and programmer of Searby to look to modify specific memory cells, as done in Kunikiyo, as such modifications would require considerable capital layout for equipment rarely found outside the factories of memory chip manufacturers.

Applicant further submits that even if Searby and Kunikiyo were combinable (which is not admitted) the teachings would still fail to teach applicant's invention. In rejecting claim 8, the examiner compared stylus 7, disclosed in Searby, with Applicant's control signal generating section. Now the examiner seeks to introduce the gate disclosed in conjunction with the RAM circuitry disclosed in Kunikiyo to the stylus 7 disclosed in Searby to overcome applicants claims 10-12. As a peripheral output device, there is no basis (nor has the examiner offered any basis) for including RAM circuitry within the stylus 7 disclosed in Searby. Therefore, the examiner has failed to provide a prima facie case overcoming claims 10-12. Also, even Searby and Kunikiyo were

combinable, a more likely location for the circuitry disclosed in Kunikiyo would be in the memory or storage components of Searby, not in the stylus.

Since, even a combination of the relied upon references would still fail to yield the claimed invention, Applicant submits that a prima facie case of obviousness for claims 10-12 has not been presented. Applicant also notes that the offered combination appears to be a (failed) attempt to reconstruct the claimed invention in hindsight, as there is no basis to combine Searby with a Kunikiyo.

Accordingly, Applicant respectfully requests that the rejection of dependent claims 10-12 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above, each of the claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

Applicant believes no fee is due with this request. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. SON-2624 from which the undersigned is authorized to draw.

Dated: April 20, 2007

Respectfully submitted,

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